



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,638	12/21/2001	Christopher Wimperis	6430	9592

7590 10/27/2003

Samuels, Gauthier & Stevens LLP
Suite 3300
225 Franklin Street
Boston, MA 02110

EXAMINER

KIM, ELLEN E

ART UNIT	PAPER NUMBER
----------	--------------

2874

DATE MAILED: 10/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/034,638	WIMPERIS ET AL.	
	Examiner	Art Unit	
	Ellen E Kim	2874	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-23 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear whether “a first optical element and a second optical element” are the first and second optical elements in claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 8, 14-20, and 23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Harden et al [USPAT 6,096,155].

Harden et al disclose a method of dicing wafer level integrated multiple optical elements including a first composite and a second composite substrate [elements 10 and 12 in fig. 1].

In re claim 8, Harden et al show in fig. 4B a plurality of optical circuits.

Claims 8, 9, and 14-16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Feldman et al [WO 01/77626].

Feldman et al disclose an etalon and the associated method.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harden et al [USPAT 6,096,155] in view of Feldman et al [WO 01/77626].

Harden et al discloses every aspect of claimed invention except for the etalon. Feldman et al disclose an etalon and the associated method. It would have been obvious to the ordinary skilled person in the art at the time the invention was made to modify Harden et al's method to include etalon as shown in Feldman et al's reference for the purpose of analyzing a wavelength of a light source.

In re claims 4-6, Harden et al do not show the amplitude filter and the beam splitters. Feldman et al, however, teach in page 10, lines 4-5 that the optical element may be a diffractive element or a refractive/diffractive hybrid element. Therefore, it is clear that any optical element can be employed for the purpose of higher coupling efficiency of the device.

Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feldman et al [WO 01/77626].

In re claims 10-12, Feldman et al do not show the amplitude filter and the beam splitters, however teach in page 10, lines 4-5 that the optical element may be a diffractive element or a refractive/diffractive hybrid element. Therefore, it is clear that any optical element can be employed for the purpose of higher coupling efficiency of the device.

In re claim 13, Feldman et al do not show the boundary surface, however, It would have been obvious to the ordinary skilled person in the art at the time the invention was made to modify the Feldman et al's device to utilize a boundary surface for the purpose of casier and accurate alignment of the optical elements in the composite substrate.

Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harden et al.

Harden et al discloses every aspect of claimed invention except for the method of testing the composite structure and the plurality of test results being extrapolated to evaluate untested portions. It would have been obvious to the ordinary skilled person in the art at the time the invention was made to modify the Harden et al's device to be tested

and the results being used to evaluate untested portions for the purpose of optimum output of the device.

Allowable Subject Matter

Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the prior art does not disclose or suggest a method of fabricating a plurality of composite optical assemblies comprising all the specific elements with the specific combination including the steps of removing a generally wedge-shaped portion of material from the exposed surface of the first composite substrate prior to forming the second composite substrate on the first composite substrate.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Further references of interest are cited on Form PLO-892, which is attachment to this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen Kim whose telephone number is (703) 308-4946. The examiner can normally be reached on Monday and Thursday.

Ellen E. Kim

Primary Examiner

October 15, 2003/EK

